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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,954	10/23/2003	Wolfgang Rein	9101.00004	6298
10534	7590	12/14/2004	EXAMINER	
BLISS MCGLYNN, P.C. 2075 WEST BIG BEAVER ROAD SUITE 600 TROY, MI 48084			GIMIE, MAHMOUD	
			ART UNIT	PAPER NUMBER
			3747	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/691,954	<b>Applicant(s)</b> REIN ET AL.	
	<b>Examiner</b> Mahmoud Gimie	<b>Art Unit</b> 3747	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 2-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 10, 12-14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenkel (4, 987, 865).

Schenkel discloses a piston (10) adapted for reciprocal movement within a cylinder of an internal combustion engine, said piston comprising: a body having a crown (12) formed at the uppermost margins of said body and a skirt (14) depending from said crown and adapted for relative sliding motion with respect to the cylinder, said skirt including an outer circumference having a major thrust side and a minor thrust side formed substantially opposite each other on said outer circumference of said skirt (14); a coating (28) bonded to said skirt so as to be juxtaposed between said skirt (14) and the cylinder, said coating (28) having a plurality of recesses (26) formed thereon so as to define a predetermined pattern of recesses (saw tooth pattern, col. 2 and ll. 43) on the surface of said skirt, said plurality of recesses (26) including a series of lubrication grooves extending across said outer circumference of said piston skirt at a predetermined angle in a chevron formation (V formation), operatively engaging lubricant between said skirt and the cylinder wall.

With regard to claim 10, the coating is a polymer coating, col. 3 and ll. 7.

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With regard to claims 12 and 13, the ridges and valley are substantially hatch-like and the major and minor thrust sides are inherently and necessarily present in the invention.

With regard to claim 14, see above.

With regard to claims 16 and 17, for the property of lubrication retention, see col. 3 and ll. 26-43, while thrust sides are inherently and necessarily present in the invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al (6,684,844).

Wang et al discloses a method of applying a predetermined pattern coating to a piston comprising the steps of: directing a silk screen having a predetermined pattern in proximate relation to the outer surface of the piston skirt; applying a coating to the outer surface of the piston skirt through the silk screen to impart a predetermined pattern, and curing the coating on the outer surface of the piston, see col. 5 and ll. 10-23.

With regard to claim 19, the method further comprising the steps of: locating the one of the thrust sides of a piston; directing a silk screen having a predetermined pattern

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specific to a particular thrust side of a piston in proximate relation to the corresponding thrust side of the piston, applying the coating to the corresponding thrust side of the piston through the silk screen to impart a predetermined pattern; locating the opposing thrust side of a piston, directing a silk screen having a predetermined pattern specific to the opposing thrust side of a piston in proximate relation to the opposing thrust side of the piston, applying the coating the opposing thrust side of the piston through the silk screen to impart a predetermined pattern, curing the coatings applied to the piston skirt (22) corresponding to the major and minor thrust sides of the piston.

With regard to directing the silk screen to the major or minor thrust side, it is inherently and necessarily present in the method of coating.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schenkel (4,987,865).

Schenkel discloses all the limitations as applied to claims 1, 10, 12, 13, 16 and 17 above except for replacing the polymer coating with a metallic coating.

At the time the invention was made; it would have been an obvious matter of design choice to a person of ordinary skill in the art to substitute polymer coating with metallic coating because applicant has not disclosed that doing so provides an advantage, is

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used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, further, would have expected applicant's invention to perform equally well with polymer coating as disclosed by Schenkel because polymer coating decreases friction between the skirt portion of the piston and the cylinder wall, see col. 1 and ll. 21-23.

***Allowable Subject Matter***

7. Claims 2-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show coated pistons.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahmoud Gimie whose telephone number is 571-272-

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4841. The examiner can normally be reached on Tuesday-Friday between 7 a.m. -3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 571-272-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG

 12/18/04  
MAHMOUD GIMIE  
PRIMARY PATENT EXAMINER  
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